

REMARKS/ARGUMENTS**I. General**

Claims 1-19, 21-28, 30-34, and 36-46 are pending in the present application. Claims 1-19, 21-28, 30-34, and 36-46 stand rejected under 35 U.S.C. § 112. Claims 1-10, 12-19, 21-28, 30-34, and 36-46 stand rejected under 35 U.S.C. § 102. Applicant respectfully traverses the rejections of record.

II. The 35 U.S.C. § 112 Rejections

Claims 1-19, 21-28, 30-34, and 36-46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As a basis for rejection of the claims under 35 U.S.C. § 112 has been set forth in the Office Action only with respect to claims 1, 2, 5, 6, 11, 15, 23, 25, and 33, it is presumed that rejection of the remainder of the claims under 35 U.S.C. § 112 stems from their dependency from one or more of the specifically identified claims. Accordingly, only claims 1, 2, 5, 6, 11, 15, 23, 25, and 33 are addressed herein with respect to the 35 U.S.C. § 112, second paragraph, rejections of record.

In rejecting claim 1 as indefinite, the Office Action states that “the recitation of ‘certain’ renders the claim indefinite because it is not clear what constitutes ‘certain’ data bits from the data stream,” Office Action at page 2. It is respectfully asserted that the adjective “certain” when used to qualify “data bits” is not indefinite because its ordinary and customary use in the English language conveys that specific, although of unspecified character and quantity, data bits are described. However, in an effort to bring the present application to issue expeditiously, Applicant has amended claim 1 to remove recitation of “certain” therein.

Claim 2 stands rejected because “the recitation of ‘printing’ renders the claim indefinite because it is not clear to which ‘printing’ (printing one or more sheets of paper information, or printing a postage indicia) function the application is referring,” Office Action at page 2. The basis for the rejection of record is unclear because claim 2 recites “printing” twice therein and, therefore, Applicant is unsure of the source of the Examiner’s consternation. In an attempt to redress the rejection of record, Applicant has removed the definite article “the” from before the first recital of “printing” to make it clear that additional printing is being introduced. Applicant has further amended recitation of “said printing” to

recite “said printing information in accordance with said data stream” to make it clear which of the previously recited printing is being referenced.

With regard to claim 5, the Office Action states that “the recitations of ‘additional’ and ‘another’ render the claim indefinite because it is not clear what kind of data the printer driver accepts and what constitutes ‘another source’,” Office Action at page 2. Applicant has amended claim 5 to remove recital of “additional” before “data” and to make it clear that the recited source is “a source other than said data stream.”

In rejecting claim 6, the Office Action states that “the recitation of ‘multiple locations’ renders the claim indefinite because it is not clear where the multiple locations are positioned (in memory? in printer driver?),” Office Action at page 2. As pending, claim 6 reads on both of the locations set forth in the Office Action. However, Applicant reminds the Examiner that breadth is not indefiniteness, see M.P.E.P. § 2173.04. As it can be readily determined whether a particular system or method directs abstracted to multiple locations, be they in memory, in a printer driver, or in a wholly separate system, the language of claim 6 is not properly the subject of a 35 U.S.C. § 112, second paragraph, rejection.

Claim 11 stands rejected because “the alternative language, ‘and/or’, renders the claim indefinite because it is not clear whether the function comprises both the change in location of the data and the format of the data, or either the change or format,” Office Action at page 3. As pending, claim 11 reads on each of the above. As discussed above, with respect to claim 6, breadth is not indefiniteness and, therefore, the fact that the claim language encompasses multiple configurations does not render it indefinite under 35 U.S.C. § 112, second paragraph. Consistent with Applicant’s position, the Manual of Patent Examining Procedure expressly authorizes the use of alternative limitations, see M.P.E.P. § 2173.05(h).

Similar to claim 1 discussed above, claim 15 stands rejected because “the recitation of ‘certain preestablished’ renders the claim indefinite because it is not clear what kind of data patterns are ‘certain preestablished’,” Office Action at page 3. As previously stated, Applicant believes that the use of the adjective “certain” in the claims is not indefinite. However, in an effort to bring the present application to issue expeditiously, Applicant has amended claim 15 to remove recitation of “certain” therein. Correspondingly, claims 17, 19,

21, and 22, dependent from claim 15, have been amended to remove recitation of “certain” therein.

With respect to claim 23, recitation of “The method” is identified in the Office Action as lacking antecedent basis, Office Action at page 3. Applicant has amended claim 23 to remove the definite article “the” and substitute therefor the indefinite article “a”.

Claim 23 further stands rejected because of recitation “may” therein. Applicant has amended the claim to remove the word “may” and more affirmatively recite “said printing device prints one or more documents from said data stream”.

Additionally, in rejecting claim 23, the Office Action states that “the recitation of ‘additional functions’ renders the claim indefinite because the applicant fails to claim the first ‘Function’ so as to claim ‘Additional Functions’ (logically, without the first function there would be no additional ones),” Office Action at page 3. Applicant respectfully asserts that a first function is recited in claim 23, that being printing of one or more documents from said data stream. Accordingly, recitation of “additional functions”, those being in addition to printing of the documents, is not indefinite.

Similar to claims 1 and 15 discussed above, claim 25 is rejected because “the recitation of ‘certain portions’ renders the claim [sic: indefinite?] due to the same reason as noted earlier,” Office Action at page 3. As previously stated, Applicant believes that the use of the adjective “certain” in the claims is not indefinite. However, in an effort to bring the present application to issue expeditiously, Applicant has amended claim 25 to remove recitation of “certain” therein. Correspondingly, claims 26 and 30, dependent from claim 25, have been amended to remove recitation of “certain” therein.

With regard to claim 33, recitation of “said computer product” is asserted to lack antecedent basis, Office Action at page 3. Applicant has amended claim 33 to recite “said computer program product”.

It is respectfully submitted that the foregoing amendments do not narrow the scope of the claims and do not introduce new matter. In light of the arguments and amendments set forth above, each of the pending claims are asserted to be allowable over the 35 U.S.C. § 112 rejections of record.

III. The 35 U.S.C. § 102 Rejections

Claims 1-10, 12-19, 21-28, 30-34, and 36-46 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Axelrod et al., patent number 4,862,386 (hereinafter *Axelrod*). Applicant respectfully traverses the rejection of record.

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant asserts that the disclosure of *Axelrod* does not teach every element of the claims, particularly in light of the disclosure thereof failing to show the identical invention in as complete of detail as is recited in the claims.

A. The Independent Claims

Independent claim 1 recites:

means for abstracting at least a portion of said data bits from said data stream; [and]
means for using at least some of said abstracted data for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia

In rejecting claim 1, the rejection of record references Figure 2d of *Axelrod* for teaching the aspect of abstracting a portion of the data stream and relies upon postage metering module 450 for using the abstracted data for controlling the function of printing of a postage indicia, Office Action at page 4. Applicant’s attorney cannot find any disclosure of abstracting a portion of data bits disclosed in Figure 2d or the description thereof. Instead, aspects of printing module 200 thereof is taught to be controlled directly by computer 120 or an operator, see column 16, lines 41-45. *Axelrod* teaches that printing module 200 may be utilized for mail or parcel marking purposes, see column 16, lines 66-67. However, computer 120 is taught to control printing of all information, see column 23, lines 10-16. Accordingly, *Axelrod* does not teach or suggest abstracting at least a portion of the data bits from a data stream sufficient to meet the claims.

Moreover, the rejection of record relies upon postage metering module 450 in meeting the means for using at least some of said abstracted data for controlling additional functions comprising printing of a postage indicia. However, postage metering module 450 is taught to receive postage printing information from computer 120 and weighing module 400 separate and apart from data provided to printing module 200, see column 25, lines 19-42. Accordingly, *Axelrod* does not teach means for using at least some of the abstracted data for controlling additional functions comprising printing of a postage indicia.

Independent claim 23 recites:

 sending a data stream to a printing device so that said printing device prints one or more documents from said data stream; [and]
 reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to said printing of said documents

In rejecting this claim, the Office Action asserts that “*Axelrod et al.* discloses . . . reviewing the data stream to create a separate data stream,” Office Action at page 5. However, even assuming the statement set forth in the rejection is accurate, the rejection under 35 U.S.C. § 102 is not properly maintainable as the claim language requires reviewing the data stream to create a separate data stream for controlling additional functions which remains unaddressed in the rejection of record.

No support is provided in the rejection of record with respect to where disclosure of reviewing the data stream to create a separate data stream may be found in *Axelrod*. Applicant’s attorney cannot find any disclosure of reviewing a data stream sent to a printing device to create a separate data stream therefrom for controlling additional functions. Instead, aspects of printing module 200 of *Axelrod* is taught to be controlled directly by computer 120 or an operator, see column 16, lines 41-45. Additionally, postage metering module 450 is taught to receive postage printing information from computer 120 and weighing module 400 separate and apart from data provided to printing module 200, see column 25, lines 19-42. Accordingly, *Axelrod* does not teach or suggest reviewing a data stream provided to a printing device to create a separate data stream for controlling additional functions sufficient to meet the claims.

Independent claim 33 recites:

an abstracting program operable for reviewing said data stream to obtain therefrom information for controlling printing operations ancillary to said printing operation

The rejection of record does not address this limitation of the claims whatsoever. Particularly, there is nothing of record with respect to the recited abstracting program. Accordingly, the Office Action does not set forth a rejection under 35 U.S.C. § 102 comporting with Office policy, see M.P.E.P. § 707.

Moreover, as discussed above with respect to claim 23, *Axelrod* does not teach reviewing a data stream directed to a general purpose printer to obtain therefrom information for controlling printing operations ancillary to the printing operation. Instead, aspects of printing module 200 of *Axelrod* is taught to be controlled directly by computer 120 or an operator, see column 16, lines 41-45. Additionally, postage metering module 450 is taught to receive postage printing information from computer 120 and weighing module 400 separate and apart from data provided to printing module 200, see column 25, lines 19-42. Accordingly, *Axelrod* does not teach an abstracting program operable as recited in the claims.

B. The Dependent Claims

Dependent claims 2-19, 21, 22, 24-28, 30-32, 34, and 36-46 are each directly or indirectly dependent from one of the above independent claims. Accordingly, without conceding that the Examiner's assertions are valid with respect to the limitations of the rejected dependent claims, it is respectfully submitted that the dependent claims are allowable at least for the reasons set forth above with respect to independent claims 1, 23, and 33.

Moreover, the dependent claims are respectfully asserted to recite additional novel and non-obvious limitations not present in the disclosure of *Axelrod*. For example, *Axelrod* does not teach or suggest an additional function accepting data from another source in addition to the control thereof from the abstracted data as represented in claim 5, nor has the Examiner asserted otherwise. Similarly, *Axelrod* does not teach or suggest directing the abstracted portion of the data stream to multiple locations as represented in claim 6, nor has the Examiner asserted otherwise. Claim 10 recites the additional function comprises delivery of data to a location remote from the printer driver, which is neither present in the disclosure of *Axelrod* nor addressed in the rejection of record. Claim 11 recites the additional function comprises the change in location and/or format of the data based upon an interaction between certain data in the data stream and data stored in the printer driver, which is neither disclosed

by *Axelrod* nor addressed in the rejection of record. *Axelrod* does not teach or suggest portions copied from the data stream include postage indicia information as represented in claim 30, nor has the Examiner asserted otherwise. Additionally, dependent claims 34 and 36-46 remain wholly unaddressed by the rejection of record.

Although aspects of many of the dependent claims are set forth in the rejection of record, rejections addressing the claim limitations as recited therein have not properly been set forth. For example, claim 2 recites abstracting a portion of data bits from the data stream for controlling an additional function, wherein the additional function comprises printing address information on material separate from the printing. In setting forth the rejection of this claim, the Office Action merely asserts that *Axelrod* discloses a printer driver “wherein the printing of a postage indicia is separate from printing,” Office Action at page 4. This assertion is insufficient to address the limitations of the claim.

The rejections set forth in the Office Action with respect to other of the claims suffer from deficiencies similar to that described above with respect to claim 2. Each such rejection is not discussed in detail herein for the sake of brevity and because Applicant has shown how the applied art does not meet the base claim. However, Applicant respectfully asks the Examiner to consider the claim limitations of each claim as a whole, see M.P.E.P. § 2106 II(C), citing *Diamond v. Diehr*, 450 U.S. at 188-98, if the arguments herein are not otherwise persuasive.

IV. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. According, the Examiner is respectfully requested to pass this application to issue.

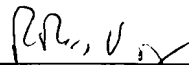
Application No.: 09/469,561

Docket No.: 61135/P016US/10106022

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P016US/10106022 from which the undersigned is authorized to draw.

Dated: July 8, 2003

Respectfully submitted,

By  _____

R. Ross Viguet

Registration No.: 42,203

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-8000

(214) 855-8200 (Fax)

Attorney for Applicant